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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,703	01/26/2004	W. Thomas Novak	6500-65537	1405
24197	7590	11/03/2005	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			SHAFER, RICKY D	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,703

Applicant(s)

NOVAK, W. THOMAS

Examiner

Ricky D. Shafer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) 3-7,9,11-14,16,27-38,42,43,51-56,58,62-76,82,83 and 86-93 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1,2,8,10,15,17-26,39-41,44-50,57,59-61,77-81,84 and 85.

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1. Applicant's election with traverse of species "B", depicted by Fig. 3, species "2", the force device being hydraulically actuated, and species "Y", the force device being hydraulically braked in the reply filed on 08/02/2005 is acknowledged. The traversal would appear to be on the ground(s) that several claims are generic. This is not found persuasive because the restriction requirement set forth in the communication mailed on June 29, 2005 is based on the claimed structural differences between the various species and not on their similarities. Continued search and examination of claims to a non-elected species having substantially different structural limitations is a prima facie showing of burden. Applicant may overcome the requirement for restriction by presenting an allowable linking claim or by providing a clear admission on the record that the claim(s) drawn to a given non-elected species is not patentably distinct from the elected species.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 3-7, 9, 11-14, 16, 27-38, 42, 43, 51-56, 58, 62-76, 82, 83 and 86-93 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Applicant timely traversed the restriction (election) requirement in the reply filed on 08/02/2005.

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 2, 39, 40 and 41, drawn to an optical system comprising a deformable optical surface, an array of force devices, wherein each force device being a member of a first set and a second set different from the first set, at least one force controller coupled to the force devices of the first set, at least one braking

controller coupled to the force devices of the second device and a moveable member (ABbr) classified in class 359, subclass 350.

- II. Claims 8, 10 and 15, drawn to an optical system comprising a deformable optical surface, an array of force devices, wherein each force device being a member of a first set and a second set different from the first set, at least one force controller coupled to the force devices of the first set, and at least one braking controller coupled to the force devices of the second device, wherein said force devices are hydraulically operated (Bsp1), classified in class 359, subclass 896.
- III. Claims 17, 47-50, 57, and 59-61, drawn to an optical system comprising a deformable optical surface, an array of force devices, wherein each force device being a member of a first set and a second set different from the first set, at least one force controller coupled to the force devices of the first set, and at least one braking controller coupled to the force devices of the second device, wherein said deformable surface is a deformable reflective surface (Bsp2), classified in class 359, subclass 358.
- IV. Claims 18-26, drawn to an optical apparatus comprising a deformable optical surface, a plurality of lockable force devices, wherein each lockable force device includes one of a plurality of braking groups and of a one of a plurality of force altering groups, a plurality of braking controllers, a plurality of force controllers and a control system to control the plurality of braking controllers and the plurality of force controllers (CBbr), classified in class 359, subclass 896.

- V. Claims 44-46, drawn to an optical system comprising a deformable optical surface, an array of force devices, wherein each force device are arranged into braking groups and force altering groups, at least one force controller coupled to the force devices of the force-altering group, and at least one braking controller coupled to the force devices of the braking group (Bsp3), classified in class 359, subclass 350.
- VI. Claims 77-81, 84 and 85, drawn to a method of adjusting a deformable optical surface comprising multiple force devices arranged into multiple sets configured to be individually actuated and individually braked, each force device includes a movable member, unlocking a set of force devices, actuating the force devices in the set and braking the force devices in the set, classified in class 359, subclass 896.
4. Claim 1 link(s) inventions I, II, III and V. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 1. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction

requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

5. Inventions I and [II, III, V] are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because of the omission of the force devices being hydraulically operated (i.e., see claims 10 and 15), the deformable optical surface being a reflective surface (i.e., see claims 17 and 47) or the force devices being into braking groups and force altering groups (i.e., see claim 44), respectively. The subcombination has separate utility such as an optical system without each force device including a movable member and/or in combination with a lithographic exposure system having extreme ultraviolet light (i.e., see claim 61).

Inventions II, III and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each of the inventions II, III and V have separate utility such as an optical system or with the separate details of the other inventions. For example, the optical system of group II has separate utility such as an optical system without a deformable reflective surface of group III or wherein each force device being arranged into braking groups and force altering groups of group V, the optical system of group III has separate utility such as an optical system without each force device being arranged into braking groups and force altering groups of group V or the force devices being hydraulically operated of group II, and the

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optical system of group V has separate utility such as an optical system without the force devices being hydraulically operated of group II or a deformable reflective surface of group III.

See MPEP § 806.05(d).

Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each of the inventions I and IV have separate utility such as an optical system or apparatus with the separate details of the other inventions. For example, the optical system of group I has separate utility such as an optical system without a plurality of braking controllers, a plurality of force controllers and a control system to control the plurality of braking and force controllers of group IV and the optical apparatus of group IV has separate utility such as an optical apparatus without an array of force devices of group I. See MPEP § 806.05(d).

Inventions VI and [I, IV] are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as one without each force device including a movable member, the force devices being individually actuated and individually braked or unlocking a set of force devices (i.e., see claims 1 and 44).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification or have acquired a separate

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status in the art because of their recognized divergent subject matter, as indicated below, restriction for examination purposes as indicated is proper.

The search required for Group II would further require a search in class 137, subclass 598 which would not be required for Groups I and III-VI.

The search required for Group IV would further require a search in class 137, subclass 38 which would not be required for Groups II and VI.

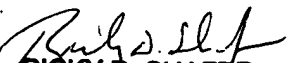
The search required for Group VI would further require a search in class 137, subclass 2 and class 355, subclass 77 which would not be required for Groups I-V.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky D. Shafer whose telephone number is (571) 272-2320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RDS

October 28, 2005


RICKY D. SHAFER
PATENT EXAMINER
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